

Serial No. 10/511,250
Atty. Doc. No. 2002P00676WOUS

REMARKS

Claims 13-32 are pending in this application. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 13-18 and 26-27 stand rejected under 35 U.S.C. 103(a) as obvious over US Pat. No. 6,253,441 (hereinafter Wheat) and evidenced by the present application. Applicant is appreciative of the recognition of allowable subject matter in connection with claims 19-25 and 28-32. Reconsideration of the rejections and allowance of all the pending claims is solicited in view of the foregoing amendments and the following remarks.

Claim 15 has been cancelled.

Claim 13 is directed to a turbine component that comprises a masking layer arranged on a portion of the component, and a plurality of material layers arranged on the component. One of the material layers is a thermal barrier coating layer applied to the masking layer. A portion of the thermal barrier coating layer and a portion of the masking layer chemically react to form a water soluble layer. The Office Action correctly acknowledges that Wheat fails to describe the structural and/or operational relationship recited in the previous sentence. Then, the Office Action impermissibly uses paragraph 36 of the present application as a basis to arrive at the claimed invention.

Reference is made to section 2143 of the M.P.E.P. that discusses the basic requirements for making a prima facie case of obviousness. This section expressly requires that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. (Underlining added by applicant), (citations omitted). In the present application, the Examiner makes impermissible use of applicant's disclosure to find what the prior art fails to teach or suggest regarding the claimed invention. Consequently, this rejection should be withdrawn since it fails to meet the requirements expressly set forth in the M.P.E.P. for making a prima facie case of obviousness.

Applicant further notes that the Wheat reference appears to teach away from the claimed invention. In particular, col. 5, lines 9-21 of Wheat describes a reusable carbon or graphite mask layer 42. This would appear to be directly inapposite to a water soluble

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layer. Applicant submits that it would be very challenging reusing a layer (Wheat) that has been solved in water (claimed invention). For all of the above reasons, it is respectfully submitted that the rejection of claims 13 and any claims depending therefrom should be withdrawn.

Claim 27 is directed to a turbine blade or vane. In part, claim 27 recites a portion of a thermal barrier coating layer and a portion of a masking layer that chemically reacts to form a water soluble layer. In view of the foregoing discussion, this rejection should similarly be withdrawn since it fails to meet the requirements expressly set forth in the M.P.E.P. for making a prima facie case of obviousness.

Conclusion:

For the foregoing reasons, it is respectfully submitted that each of the pending claims comply with all applicable statutory requirements, and consequently are in form ready for allowance. Accordingly, applicant respectfully requests that the Examiner withdraw the rejections and timely pass the application to allowance.

Please grant any extensions of time required to enter this paper. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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